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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,736	11/13/2003	Indran Naick	AUS920030776US1(4015)	2704

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EXAMINER
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JEAN GILLES, JUDE

ART UNIT	PAPER NUMBER
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2143

MAIL DATE	DELIVERY MODE
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08/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/713,736

Applicant(s)

NAICK ET AL.

Examiner

Jude J. Jean-Gilles

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2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This office action is responsive to communication filed on 05/19/2007.

#### ***Information Disclosure Statement***

1. The references listed on the Information Disclosure Statement submitted on 11/13/2003 have been considered by the examiner (see attached PTO-1449A).

#### ***Response to Amendment/Arguments***

2. In the claims, no claim has been amended, and claim 21 is newly added. Claims 1-21 are pending and represent a method and apparatus for a "OPTIONAL RECEIPT OF AN EMAIL ATTACHMENT."

Applicant's arguments with respect to claims 1, 10, and 17 have been carefully considered, but are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the grounds of rejection as explained here below. Applicants' amendments adding new claim 21 are not properly made as to perhaps place this application in condition for allowance.

In response to Applicant's arguments, 37 CFR § 1.11(c) requires applicant to "clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must show the amendments avoid such references or objections."

Applicant's Request for Reconsideration filed on 05/19/2007 has been carefully considered but is not deemed fully persuasive. However, because there exists the

likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention:

A: Applicant contends that "the cited sections of Godfrey are directed to receiving meeting requests, whereas Applicant's independent claims 1, 10 and 17 are directed to *selectively* transmitting *an email attachment*. At the outset, as set forth in the preamble of independent claims 1, 10 and 17, the cited sections of Godfrey fail to describe the limitation of both *selectively* transmitting and transmitting *an email attachment*. That is, Godfrey is directed to solving a calendaring problem, and Applicant's invention is directed toward limiting the proliferation of email attachments by allowing selective transmission of a received email. So, Godfrey and Applicant are solving disparate, non-overlapping problems. For these reasons, Applicant respectfully asserts that Godfrey fails to anticipate Applicant's independent claim 1, and by analogy, independent claims 10 and 17, as a matter of law."

B: Applicant contends that "Applicant's independent claim 1 first states, "receiving an instruction from a sender to add a selectable notification of an email attachment to a first email." This claim element and its limitations include, for example, an email client having the capability for a email sender to add a "selectable notification," such as coded instruction, to allow retrieval of an email attachment associated with the sender's first email through a second email that the sender sends to the recipient of the first email. Nowhere in the cited sections of Godfrey is this element and its limitations described at all."

C : Applicant contends that "Applicant's independent claim 1 then states,

"inserting code in the first email to transmit a reply to the sender upon execution of the code by an email client, wherein execution is responsive to activation of the selectable notification by a recipient." Again, nowhere in the cited sections of Godfrey is this second element and its limitations described. "

D : Applicant contends that "Applicant's independent claim 1 next states, "generating a second email having the email attachment upon receipt of the reply." The cited sections again do not describe this third element and its limitations of generating a second email with the email attachment upon receipt by the email sender of a reply from the email recipient occurring by the email recipient executing a selectable notification."

E: Applicant contends that "Applicant's independent claim 1 finally states, "transmitting the second email to the recipient in response to the reply." At the cited sections, and in line with Applicant's argument *supra*, there is nothing in Godfrey that describes Applicant's *transmitting of any second email* in response to the *reply* as defined in Applicant's application."

As to point A, It is the position of the Examiner that Godfrey teaches the limitations of the claimed invention. Applicant's argument is that Godfrey is directed to solving a calendaring problem, and Applicant's invention is directed toward limiting the proliferation of email attachments by allowing selective transmission of a received email. So, Godfrey and Applicant are solving disparate, non-overlapping problems. The Examiner disagrees. Godfrey teaches as stated by the applicant means to solving a

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calendaring problem with is directly related selective transmission of received email with attachment (see Godfrey, column 5; see also figs. 8, and 9).

As to point B, the limitations of allowing retrieval of an email attachment associated with the sender's first email through a second email that the sender sends to the recipient of the first email is disclosed by Godfrey in column 5 , figs, 8 and 9; it is important to note that the first email email is represented by the transformation of the first meting request and reply is sent by the recipient of the email with the attachment.

As to point C, the limitations of "inserting code in the first email to transmit a reply to the sender upon execution of the code by an email client, wherein execution is responsive to activation of the selectable notification by a recipient" is taught by Godfrey using the redirector's application code to insert the attachment and reply the email.

As to point D, "generating a second email having the email attachment upon receipt of the reply" is taught in column 5 of Godfrey as well as figs. 8, and 9.

As to point D, see point C and D above.

Examiner notes that no matter has been added and that new claim 21 is not supported by the application as filed. Furthermore, applicant has failed in presenting claims and drawings that delineate the contours of this invention as compared to the cited prior art. Applicant has failed to clearly point out patentable novelty in view of the state of the art disclosed by the references cited that would overcome the 102(e) applied against the claims, the rejection is therefore sustained.

***Claim Rejections - 35 USC § 112***

3. Claim 21 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The new claim 21 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 21, newly added in the Reply dated 05/19/2007, comprises language that is not spelled out in the specifications as originally claimed. Applicants simply allege in page 10 of the Reply that proposed new claim 21 is supported by the specification, does not add any new matter, and request entry and allowance. The Examiner disagrees. Specifically, Applicants have claimed a "detacher" in line 3 of claim 21 which is not mentioned or described in the specifications. Paragraphs 0024 and 0057 of the specifications, each briefly mentions the word detach once with no correlation to a detacher.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-20** are rejected under 35 U.S.C. 102(e) as being anticipated by Godfrey et al (Godfrey), Patent No. 6,941,349 B2.

Regarding **claim 1-20**, Godfrey discloses:

1. A method for selectively transmitting an email attachment, the method comprising:

receiving an instruction from a sender to add a selectable notification of an email attachment to a first email (figs. 12, and 13; column 5, lines 33-59; note that accepting and declining the meeting request inherently comprises the step of selecting the notification; and that the first meeting request received at the host is in the form of an email);

inserting code in the first email to transmit a reply to the sender upon execution of the code by an email client, wherein execution is responsive to activation of the selectable notification by a recipient (column 5, lines 32-67; note the sending of the email with the attachment as a reply to the sender);

generating a second email having the email attachment upon receipt of the reply; and transmitting the second email to the recipient in response to the reply (column 5, lines 45-60; note that step 1 through 8 can be repeated to create the second reply from the sender with the email attachment).



2. The method of claim 1, further comprising prompting the recipient prior to transmission of the reply to the sender (column 19, lines 33-42).
3. The method of claim 2, wherein prompting the recipient comprises requesting the recipient add comments for the sender to the reply (column 19, lines 33-42).
4. The method of claim 1, further comprising prompting the sender prior to transmission of the second email to the recipient (column 5, lines 45-60; repeat steps 1 through 8).
5. The method of claim 4, wherein prompting the sender comprises requesting the sender to locate the email attachment to transmit the second email to the recipient (figs. 12, and 13; column 5, lines 45-60; repeat steps 1 through 8).
6. The method of claim 4, wherein prompting the sender comprises requesting the sender add comments for the recipient to the second email (column 5, lines 45-67).
7. The method of claim 1, wherein receiving the instruction comprises receiving the instruction to exclude the email attachment from the first email (column 19, lines 24-52);
8. The method of claim 1, wherein inserting code in the first email comprises inserting a markup language (figs. 12, and 13).

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9. The method of claim 1, wherein inserting code in the first email comprises inserting an icon and linking the code to the icon (figs. 12, and 13).

10. A device for selective transmission of an e-mail attachment by a recipient, the device comprising: a notification incorporator to add a selectable notification of an email attachment to a first email in response to an instruction from a sender (figs. 12, and 13; column 5, lines 33-59); a code associator to insert code in the first email to transmit a reply to the sender upon execution of the code by an email client and to associate execution of the code with activation of the selectable notification by the recipient (column 5, lines 32-67); and an attachment responder to generate a second email having the email attachment upon receipt of the reply and to transmit the second email to the recipient in response to the reply (column 5, lines 45-60; note that step 1 through 8 can be repeated to create the second reply from the sender with the email attachment).

11. The device of claim 10, wherein the code associator inserts code comprising at least one prompter, wherein the at least one prompter permits optional entry of text in the reply (figs. 12, and 13).

12. The device of claim 10, wherein the attachment responder comprises at least one prompter, wherein the prompter permits optional entry of text in the second email (figs. 12, and 13; column 5, lines 45-60; repeat steps 1 through 8).

13. The device of claim 10, wherein the attachment responder comprises at least one prompter, wherein the prompter requests the sender to locate the email attachment (figs. 12, and 13; column 5, lines 45-60; repeat steps 1 through 8).

14. The device of claim 10, wherein the notification incorporator is responsive to the instruction, wherein the instruction excludes the email attachment from the first email (figs. 12, and 13; column 5, lines 45-60; repeat steps 1 through 8).

15. The device of claim 10, wherein the code associator inserts code comprising a markup language (figs. 12, and 13).

16. The device of claim 10, wherein the code associator inserts an icon and associates the icon with the code (figs. 12, and 13).

17. A machine-accessible medium containing instructions, which when executed by a machine, cause the machine to perform operations for selective transmission of an e-mail attachment, comprising: receiving an instruction from a sender to add a selectable notification of an email attachment to a first email (figs. 12, and 13; column 5, lines 33-59); inserting code in the first email to transmit a reply to the sender upon execution of the code by an email client, wherein execution is responsive to activation of the selectable notification by a recipient (column 5, lines 32-67); generating a second email

having the email attachment upon receipt of the reply; and transmitting the second email to the recipient in response to the reply (column 5, lines 45-60; note that step 1 through 8 can be repeated to create the second reply from the sender with the email attachment).

18. The machine-accessible medium of claim 17, wherein the operations further comprise instructions for prompting the recipient prior to transmission of the reply to the sender (figs. 12, and 13; column 5, lines 45-60; repeat steps 1 through 8).

19. The machine-accessible medium of claim 17, wherein the operations further comprise instructions for prompting the sender prior to transmission of the second email to the recipient (figs. 12, and 13; column 5, lines 45-60).

20. The machine-accessible medium of claim 20, wherein prompting the sender comprises requesting the sender to locate the email attachment to transmit the second email to the recipient (column 5, lines 45-67; *note that step 1 through 8 can be repeated to create the second reply from the sender with the email attachment*).

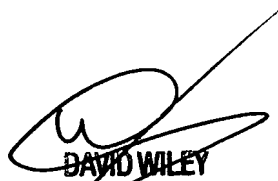
**Conclusion**

56. **THIS ACTION IS MADE FINAL.** Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-9000.

Jude Jean-Gilles  
Patent Examiner  
Art Unit 2143



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
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JJG

August 3, 2007